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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/365,613	08/02/1999	GUNTER WOLF		2005

30996 7590 07/07/2003

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TIJERAS, NM 87059

EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 07/07/2003

*10*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/365,613

Applicant(s)

WOLF ET AL.

Examiner

Donald Heckenberg

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☒ Claim(s) 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/900,101.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Applicant's election with traverse of Group I (claims 1-15) in Paper No. 9 is acknowledged. The traversal is on the grounds that claims 16 and 17 represent product by process claims. This is not found persuasive because the determination of patentability in product by process claims is based on the product itself. The patentability of a product does not depend on its method of production. In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Brown, 459 F.2d 531, 173 USPQ 685 (Cust. & Pat. App. 1972); In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (Cust. & Pat. App. 1969). Therefore, the product could be made by a material different apparatus, such as an apparatus comprising four mold pieces which combine to form the negative of the grip to be molded.

The requirement is still deemed proper and is therefore made FINAL.

2. The continuity data at the beginning of the specification needs to be updated to reflect that the parent application (09/365,613) has been abandon.

3. The abstract of the application is objected to as it is too long. The abstract needs to be less than 150 words or less. See MPEP 608.01(b).

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is written as an improper dependent claim as it depends from itself, and is therefore indefinite. Based on the disclosure, it is believed that this claim was meant to depend from claim 1. Appropriate clarification and correction is required.

6. Claims 1-14 are allowed.

7. Claim 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

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8. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a mold for molding a grip, the mold comprising a first mold half and a second mold half; the first mold half having a first mold separation surface and a second mold half having a second mold separation surface; the first mold half having a first depression and the second mold half having a second depression, wherein the first and second depressions combined are a negative of a grip to be molded, wherein the negative has a first portion, the first portion having a first elliptical cross-section, for molding the top grip portion and a second portion, having a second elliptical cross-section, for molding the lateral grip portion, wherein the first and second cross-section are identical, the cross sections having a first and second diameter, the first diameter being larger than the second diameter, the first cross-section rotated relative to the second cross-section in a circumferential direction of the negative by an angle of rotation, the first and second depressions having integral, elongate, recesses extending in a longitudinal direction of the first and second depressions are distributed adjacent to one another in the circumferential direction of the negative the recesses extending spirally along the first and

second portions of the negative, the first and second mold separation surfaces positioned within a longitudinal center plane of a respective one of the recesses neighboring the first diameter and thus following the angle of rotation.

The closest prior is disclosed by Lapeyre (U.S. Pat. No. 4,871,505). Lapeyre discloses a molding cavity with a spiral shape, along with mold separation surfaces in the spiral shape. Lapeyre fails to teach or suggest the molding cavity to be a elliptical cross-section first and second diameter, and with the cross sections rotated relative in a circumferential direction by an angle of rotation with the mold separation surfaces position in the longitudinal center plane of the recesses neighboring the first diameter and thus following the angle of rotation. Lapeyre also does not teach or suggest depressions in the molding cavity.

9. The following references are cited, but not relied upon, as being pertinent to the instant application:


Murphy et al. (U.S. Pat. No. 6,352,662) discloses a mold for forming a grip on a shaft.


Japanese Pub. No. 03-187720 discloses a grip molding apparatus.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action, and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.

  
Donald Heckenberg  
June 26, 2003

  
JAMES P. MACKEY  
PRIMARY EXAMINER  
6/27/06